

**FILED**

**SEP 17 2007**

RICHARD W. WIEKING  
CLERK, U.S. DISTRICT COURT  
NORTHERN DISTRICT OF CALIFORNIA

Henry C. Bunsow (SBN 60707)  
bunsowh@howrey.com  
Denise De Mory (SBN 168076)  
demoryd@howrey.com  
Brian A.E. Smith (SBN 188147)  
smithbrian@howrey.com  
HOWREY LLP  
525 Market Street, Suite 3600  
San Francisco California 94105  
Telephone: (415) 848-4900  
Facsimile: (415) 848-4999

Attorneys for Defendant  
AuthenTec, Inc.

UNITED STATES DISTRICT COURT  
NORTHERN DISTRICT OF CALIFORNIA  
OAKLAND DIVISION

ATMEL CORPORATION, a Delaware  
corporation; ATMEL SWITZERLAND, a  
corporation; ATMEL FRANCE, a corporation;  
and ATMEL SARL, a corporation,

Plaintiffs,

v.

AUTHENTEC, INC., a Delaware corporation,  
Defendant.

Case No. 06 CV 2138 CW

**REQUEST FOR INTERNATIONAL  
JUDICIAL ASSISTANCE PURSUANT TO  
THE HAGUE CONVENTION THE TAKING  
OF EVIDENCE ABROAD IN CIVIL OR  
COMMERCIAL MATTERS  
(HAGUE CONVENTION #20)**

**IDENTITY AND ADDRESS OF THE APPLICANT:**

Honorable Elizabeth Laporte  
United States District Court for the Northern District of California  
San Francisco Division  
Courtroom E, 15<sup>th</sup> Floor  
450 Golden Gate Avenue  
San Francisco, CA 94102

**CENTRAL AUTHORITY OF THE RECEIVING STATE:**

M. Michel RISPE  
Ministère de la Justice  
Direction des Affaires Civiles et du Sceau  
Bureau de l'entraide civile et commerciale internationale (D3)  
13, Place Vendôme  
75042 Paris Cedex 01  
FRANCE  
Téléphone: 33 (1) 44 77 66 34

HOWREY LLP

Request for International Judicial Assistance Pursuant to Hague Convention #20  
Case No. 06 CV 2138 CW  
Thales Research & Technology, France - FRANCE

In conformity with Article 3 of Hague Convention #20, the undersigned applicant has the honor and judicial authority to submit this request on behalf of the Defendants in the above-entitled action.

The United States District Court, for the Northern District of California, by and through the Honorable Elizabeth Laporte, presents its compliments to the judicial authorities of France, and requests international judicial assistance to obtain evidence to be used in a civil proceeding before this court in the above-captioned matter.

A trial on this matter is currently scheduled to take place in California. This court requests the assistance described herein as necessary in the interests of justice.

Below are the names of all parties in this matter and their representatives:

Party	Legal Representative
<b>PLAINTIFFS:</b> Atmel Corporation Atmel Switzerland Atmel France Atmel SARL By and through counsel: Denise McKenzie, Esq. Sidley Austin LLP 555 West Fifth Street, Suite 4000 Los Angeles, California 90013-1010 United States of America Telephone (213) 896-6000	Denise McKenzie, Esq. Sidley Austin LLP 555 West Fifth Street, Suite 4000 Los Angeles, California 90013-1010 United States of America Telephone (213) 896-6000
<b>DEFENDANTS:</b> AuthenTec, Inc. By and through counsel: Denise De Mory, Esq. Howrey LLP 525 Market Street, Suite 3600 San Francisco, California, 94105 United States of America Telephone (415) 848-4900	Henry C. Bunsow, Esq. Denise De Mory, Esq. Brian A.E. Smith, Esq. Howrey LLP 525 Market Street, Suite 3600 San Francisco, California, 94105 United States of America Telephone (415) 848-4900 Fax (415) 848-4999

#### REPRESENTATIVE TO ACT ON BEHALF OF DEFENDANTS:

It is requested that should contact or correspondence with Defendants in this matter be required, the following individual is appointed in this matter to represent Defendants:

Denise De Mory, Esq.  
 Howrey LLP  
 525 Market Street, Suite 3600  
 San Francisco, California, 94105  
 United States of America  
 Telephone (415) 848-4900  
 Fax (415) 848-4999

HOWREY LLP

Request for International Judicial Assistance Pursuant to Hague Convention #20  
 Case No. 06 CV 2138 CW  
 Thales Research & Technology, France - FRANCE

1 **ENTITY FROM WHOM EVIDENCE IS REQUESTED:**

2 **Thales Research & Technology, France**  
 3 Route départementale 128  
 91767, Palaiseau cedex  
 4 France

5 It is believed that **Thales Research & Technology, France** is a business entity registered to do  
 6 business in France.

7 **SUBJECT MATTER AND RELATIVITY OF THIS REQUEST:**

8 Atmel filed a complaint against AuthenTec, Inc. ("AuthenTec") in the United States District  
 9 Court for the Northern District of California alleging patent infringement ("Atmel Lawsuit"). The two  
 10 patents asserted against AuthenTec relate to fingerprint sensors. Based on documents that AuthenTec  
 11 has received in this case, AuthenTec believes that the two patents asserted by Atmel may be invalid  
 12 due to inventorship by another and/or an on sale bar. AuthenTec believes that evidence of prior  
 13 inventorship and/or an on sale bar is in the possession, custody and control of **Thales Research &**  
 14 **Technology, France**, in part, because Atmel has produced documents authored by the inventor of the  
 15 asserted patents referencing **Thales Research & Technology, France**. AuthenTec also believes that  
 16 the inventor of the asserted patents was employed by a predecessor company to **Thales Research &**  
 17 **Technology, France**. The requested documents and information from **Thales Research &**  
 18 **Technology, France** are therefore relevant to and necessary for trial of this case.

19 **SPECIFIC REQUESTS:**

20 The District Court respectfully requests that these documents and information be produced  
 21 quickly, but if at all possible within 30 days after receipt of this request, at a place and time designated  
 22 by the French court having competent jurisdiction over this request.

23 In view of the foregoing, we therefore request, in the interest of justice, that you issue an order  
 24 for the acquisition of the evidence requested below, in accordance with the laws and procedures of the  
 25 courts of France, and summon the appropriate employee, director, officer or other appropriate  
 26 representative of **Thales Research & Technology, France**, in possession or control of the evidence  
 27 requested, to submit the evidence requested to a duly appointed authority in France, in an expeditious  
 28 manner, for examination by the below signed authority.

**EVIDENCE TO BE OBTAINED:**

**A. Definitions.**

In addition to the abbreviated terms identified above, for the purposes of this request:

(1) the terms “you” and “your” mean **Thales Research & Technology, France**, including, without limitation, all predecessors (merged, acquired, or otherwise), successors, subsidiaries, parents, sisters, partnerships and affiliates thereof, and all directors, officers, agents, employees, attorneys, and other persons acting on their behalf;

(2) the term “Thompson-CSF” means Thomson-CSF and all predecessors (merged, acquired, or otherwise) successors, subsidiaries, parents, sisters, partnerships and affiliates thereof, including but not limited to IDmatics and Laboratoire Central de Recherches, and all directors, officers, agents, employees, attorneys, and other persons acting on their behalf;

(3) the term “Thomson-CSF Semiconducteurs Specifiques” means Thomson-CSF Semiconducteurs Specifiques, including but not limited to Atmel Grenoble, and all predecessors (merged, acquired, or otherwise), successors, subsidiaries, parents, sisters, partnerships and affiliates thereof, and all directors, officers, agents, employees, attorneys, and other persons acting on their behalf;

(4) the term “Atmel” means Atmel Corporation, Atmel SARL, Atmel France, Atmel Switzerland, Atmel Grenoble and all predecessors (merged, acquired, or otherwise), successors, subsidiaries, parents, sisters, partnerships and affiliates thereof, and all directors, officers, agents, employees, attorneys, and other persons acting on their behalf.

(5) the term “fingerprint sensor” means all mechanical, electronic, optical, electro-optical, capacitive, reflection, RF, pressure, temperature, ultrasound, and micro-electro-mechanical systems and devices designed to read a fingerprint for authenticating individuals, including but not limited to all prototypes and experiments related to such sensors and further including but not limited to strip and/or swipe sensors;

(6) the term “fingerprint sensing technologies” means all hardware, software, and other components that may be incorporated into or work in conjunction with a fingerprint sensor, including but not limited to electronic circuitry, microchips, elements, conductive layers, and algorithms further

1 including but not limited to image stitching algorithms;

2 (7) the word “document” includes any written, printed, typed, recorded, computerized,  
3 electronic, taped, graphic, or other matter, in whatever form, whether in final or draft, including but not  
4 limited to all materials that constitute “writings,” “recordings,” “photographs,” “source code” or  
5 “executable code” within the broadest meaning of Rule 1001 of the Federal Rules of Evidence and all  
6 materials that constitute “documents” within the broadest meaning of Rule 34 of the Federal Rules of  
7 Civil Procedure. The word “document” includes, without limitation, printed matter, electronic mail,  
8 materials stored on computer hard drives, diskettes, tapes, any other computer media, and any other  
9 information stored magnetically, optically or in any electronic medium and/or form;

10 (8) the term “communication” includes, without limitation, communications by whatever  
11 means transmitted (i.e., whether oral, written, electronic or other methods used), as well as any note,  
12 memorandum or other record thereof;

13 (9) the term “FingerChip” means the fingerprint sensor manufactured by the Atmel  
14 Corporation, including but not limited to the fingerprint sensing technologies developed by Jean-  
15 Francois Mainguet and incorporated into the FingerChip product.

16 **B. Documents requested.**

17 The District Court requests the production of the following documents, which are in the  
18 possession, custody, or control of **Thales Research & Technology, France**:

19 1. Documents relating to or referring to United States Patent No. 6,289,114 (“the ’114 patent”) or  
20 United States Patent No. 6,459,804 (“the ’804 patent”) titled “Fingerprint-Reading System.”

21 2. Documents relating to or referring to fingerprint sensors and/or fingerprint sensing  
22 technologies consisting of: (1) sensors with a surface area smaller than the surface area of a finger,  
23 and/or (2) combining partial fingerprint images to create a more complete fingerprint image, and/or (3)  
24 collection of fingerprint data by movement of a finger over a fingerprint sensor, including but not  
25 limited to publications, articles, patents, patent applications, schematics, lab notebooks, and manuals.

26 3. Documents relating to or referring to communications prior to June 5, 1997 between you  
27 and Jean-Francois Mainguet, or any other person employed by or associated with Thomson-CSF  
28 and/or Thomson-CSF Semiconducteurs Specifiques, concerning fingerprint sensors and fingerprint

1 sensing technologies, including but not limited to FingerChip.

2 4. Documents related to or referring to collaboration between Mr. Rajenbach and Jean-  
3 Francois Mainguet concerning fingerprint recognition algorithms, fingerprint sensors, and/or  
4 fingerprinting technologies.

5 5. Documents relating to or referring to communications between you and Thomson-CSF,  
6 Thomson-CSF Semiconducteurs Specifiques, and/or Atmel concerning licensing, offers to license,  
7 infringement, invalidity and/or that affect in any way rights related to the '804 patent and/or the '114  
8 patent.

9 6. Documents relating to or referring to communications evidencing existence of an attorney-  
10 client relationship and/or privilege between you and Atmel.

11 7. Documents evidencing any rights you have in the '804 patent and/or '114 patent.

12 8. Documents relating to or referring to communications between you and Atmel concerning  
13 fingerprint sensors and fingerprint sensing technologies.

14 The documents and information requested above are for use as evidence in the Atmel Lawsuit,  
15 including for use at trial. This Court makes this request to secure production of documents and  
16 information from **Thales Research & Technology, France**, which resides in the jurisdiction of  
17 France, and this Court confirms that this is proper and necessary to request since it relates to  
18 AuthenTec's counterclaims and defenses and is necessary for a fair resolution of issues at trial.

19 It is requested that should any portion of this request, or subject questions as described below,  
20 be denied on legal grounds, that such denial not affect the remainder of this request.

21 It is requested that any evidence produced be marked, attested, properly sealed by the  
22 appropriate authorities of France and returned through appropriate channels to the below signed  
23 authority

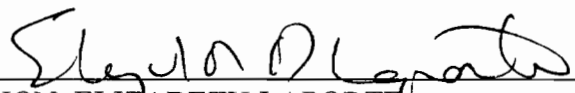
24 Defendant AuthenTec, through counsel Howrey LLP (525 Market Street, Suite 3600, San  
25 Francisco, California 91405, United States of America, Telephone: (415) 848-4900), will reimburse  
26 the appropriate judicial authorities in France, for all costs incurred in executing the below signed  
27 judicial authority's request for international judicial assistance.

1 When required, the below signed judicial authority shall provide reciprocal assistance, such as  
2 requested herein, to the appropriate judicial authorities of France.

3 The United States District Court for the Northern District of California extends the assurance of  
4 its highest consideration to the judicial authorities of France.

5 Date of Request: Sept 19, 2007.

6  
7 By:

  
HON. ELIZABETH LAPORTE  
UNITED STATES DISTRICT COURT JUDGE  
United States District Court  
Northern District of California  
San Francisco Division  
Courtroom E, 15<sup>th</sup> Floor  
450 Golden Gate Avenue  
San Francisco, CA 94102

8  
9  
10  
11  
12  
13 [Seal]  
14  
15  
16  
17  
18  
19  
20  
21  
22  
23  
24  
25  
26  
27  
28